

Copyright Infringement, Trademark Infringement, and Social Media

CLE for the US District Court of Puerto Rico

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Good morning !

- Today, I will look at various cases and their history that examine:
 - Trademarks, domain names, and Print-on-Demand.
 - Copyright Fair Use, and
 - Originality in Copyright, and
 - Sovereign Immunity and “Takings.”
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- First, though, I would like to cover some recent Supreme Court cases.

Trademarks – Section 2(a)’s “May Disparage” Language.

- There were two different trademark cases in front of the Supreme Court that dealt with whether certain bars on registration were constitutional.
- The Supreme Court held that portions of Section 2(a) of the Lanham Act were unconstitutional.
- This was after **all courts** had held that they were **constitutional for over 70 years**.
- Section 2 provides that **“No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—**
- **(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute”**

Trademarks – *Matal v. Tam*, ____ U.S. ____, 137 S.Ct. 1744 (2017).

- *Matal v. Tam* was an interesting case.
- **Simon Tam** is an Asian-American musician in a rock band.
- He wanted to register the name, “The Slants,” for his band.
- The PTO held that the name, “The Slants,” may disparage Asians and rejected the mark.
- **Note:** In most cases, the party challenging the mark on § 2(a) was **not the party who was registering the mark**. For example, in *Harjo v. Washington Redskins*, the mark was already in existence when a member of a Native American tribe attempted to cancel it.

Trademarks – *Matal v. Tam*, ____ U.S. ____, 137 S.Ct. 1744 (2017).

- The “scandalous” and “immoral” language in § 2(a) were not at issue in this case. (They were saved for another case. More on that later.)
- The Trademark Trial and Appeals Board affirmed the rejection under § 2(a).
- It went up to the **Federal Circuit** on appeal under 15 U.S.C. § 1071(a). A party has the option of going to the Federal Circuit or going to the District Court under 15 U.S.C. § 1071(b).
- Judge Kimberly Moore first affirmed the TTAB’s rejection.
- Then, I guess, Judge Moore could **not sleep well**, for she **vacated her earlier opinion**, and wrote an opinion taking the **polar opposite view**.
- **The “may disparage” language in § 2(a) was unconstitutional.**

Trademarks – *Matal v. Tam*, ____ U.S. ____, 137 S.Ct. 1744 (2017).

- In all other refusals to register cases, the court had said something along the lines of “**Registration is no big deal**; you may not be able to register the mark under today’s decision, but you may still **use the mark**. You just cannot have any of the benefits of registration.”
- The benefits of registration include:
 - 1) A presumption of validity.
 - 2) constructive notice,
 - 3) the ability to stop infringing goods from coming into the country,
 - 4) the ability to bring an *ex parte* seizure order against counterfeits.

Trademarks – *Matal v. Tam*, ____U.S.____, 137 S.Ct. 1744 (2017).

- Now, **registration was a big deal.**
- Judge Moore said, **there are substantial substantive benefits that one gets from registration and to deny registration is to deny one benefits.**
- **Registration is not government speech.**
- **It is not a government subsidy to registrants.**
- And, Section 2(a) is **unconstitutional** because it:
 - **1) is content related and viewpoint based**
 - **2) is arbitrarily applied.**

Trademarks – *Matal v. Tam*, ____ U.S. ____, 137 S.Ct. 1744 (2017).

- It was appealed to the **Supreme Court, which affirmed the case.**
- In over 70 years, refusals to register were considered to be in accordance with § 2(a). Why now was it unconstitutional?
- You may now register almost anything, provided that it doesn't offend other **Section 2 bars.**
- It is **unconstitutional; it does not prevent registrations.**
- **There are not some agreed upon words that cannot be registered.**
- This personally surprised me. I thought that certain **ethnic “hate speech” would be disallowed.**

Trademarks – *Iancu v. Brunetti*, ____ U.S. ____, 139 S. Ct. 2294 (2019)

- This case deals with the “**scandalous**” and “**immoral**” bars to registration. (The others parts of § 2(a) that were unconstitutional.)
- In *Iancu v. Brunetti*, the defendant applied to use the word, “**FUCT**,” - in connection with clothing - registered with the USPTO.
- The PTO rejected it; the TTAB rejected it.
- Judge Moore, writing **again** for the Federal Circuit, reversed the rejection and held that the “**scandalous**” and “**immoral**” language was **unconstitutional for largely the same reasons as in *Matal v. Tam*.**
- The Supreme Court took the case because it was invalidated under a Constitutional provision. **The Supreme Court affirmed.**

United States Patent and Trademark Office v. Booking.com B. V., ___ U.S. ___, 140 S.Ct. 2298 (2020)

- In ***Booking.com***, the issue was “may adding a ‘.com’ to a generic mark turn the generic term into a Trademark.”
- The Supreme Court held that:
 - 1) While “Booking” was **generic** for “making reservations,” “Booking.com” was **not generic** for federal trademark registration purposes, and
 - 2) whether any given “generic.com” term is **generic** for federal trademark registration purposes depends on **whether consumers in fact perceive that term as the name of a class or, instead, as a term capable of distinguishing among members of the class.**

United States Patent and Trademark Office v. Booking.com B. V., ___U.S.___, 140 S.Ct. 2298 (2020)

- “**Booking.com**” would not yield its holder a monopoly on the term “**booking.**”
- There is no **categorical rule.**
- An unyielding legal rule that **entirely disregards consumer perception is incompatible with a bedrock principle of the Lanham Act.**
- The generic (or non-generic) character of a particular term depends on its meaning to consumers, *i.e.*, **do consumers in fact perceive the term as the name of a class or, instead, as a term capable of distinguishing among members of the class.**

United States Patent and Trademark Office v. Booking.com B. V., ___U.S.___, 140 S.Ct. 2298 (2020)

- **Dissent: Justice Breyer**
- “What is Booking.com? To answer this question, one need only consult the term itself. Respondent provides an online booking service. The company’s name informs the **consumer of the basic nature of its business and nothing more**. Therein lies the root of my disagreement with the majority.”
- In the past, we held that the addition of a corporate designation, **“only indicates that parties have formed an association or partnership to deal in such goods.”**
- It did not create a trademark.

Trademarks: A History of Internet Trademark Infringement.

- In around 1995, the Internet became a Graphic User Interface (“GUI”).
- Before that the Internet was DOS-based.
- The first cases dealt with the **uncertainty** of the Internet; Were domain names like **real estate**,
- or were they based on **trademark law**.
- Were there any restrictions of getting a domain name?

Josh Quittner and NSI

- The original Internet registrar was Network Solutions, Inc. (“NSI”).
- NSI had a **“first-come/first served”** policy of issuing domain names.
- That could lead to problems, as illustrated below:
- Josh Quittner, a writer at *Wired* magazine called NSI and said, **“I would like to register ‘mcdonalds.com.’”**
- Scott Williamson, an NSI supervisor said, “There’s nothing that says that I can stop you from doing that.”
- Quittner: “Which means that I could register mcdonalds.com.”
- Williamson said, “Yes,” and then said “We really need some policy.”
- McDonald’s and Quittner settled. He convinced McDonalds to buy some computers for a public school in NYC in exchange for the name.

“Squatters” and Trademark Dilution

- The next few cases dealt with defendants who had received numerous “Trademark.com” domains from NSI.
- **The case was brought under the newly passed anti-dilution law, 15 U.S.C. § 1125 (c) or Section 43(c) of the Lanham Act.**
- The first case to thoroughly discuss anti-dilution and domain names was *Intermatic v. Toeppen*.
- *Intermatic v. Toeppen*, 40 U.S.P.Q.2d 1412 (N.D. Ill. 1996) – Toeppen had registered 240 domain names through NSI, including: deltaairlines.com, neimanmarcus.com, ussteel.com, unionpacific.com, and **intermatic.com**.

“Squatters” and Trademark Dilution

- The court found that “**Intermatic**” was a **famous mark** under Section 43(c).
- It was a **commercial use** because had the **intent to sell** the name back to Intermatic, and
- It was a **use in commerce** because the domain name was **on the Internet**.
- **Intermatic** won the case.
- QUESTION: Does anyone here know what **Intermatic** is or was?

Other “Squatter” cases.

- **Panavision International LP v. Toeppen**, 945 F. Supp. 1296 (C.D. Cal. 1996) (same result) (aerial view of Pana, Illinois, on Toeppen’s site)
- **Toys “R” US, Inc. v. Akkaoui**, 1996 U.S. Dist. LEXIS 17090 (N.D. Cal. 1996).
 - **Akkaoui** registered the domain name “**adultsrus.com**” in connection with an Internet website for “sexual devices and clothing.”
 - The court found “R US” to be **famous** and eligible for protection under Section 43(c). An injunction was issued.
- **Hasbro v. Internet Entertainment Group, Ltd**, 40 U.S.P.Q. 1479 (W.D. Wash. 1996) .
- **I E G**, registered the name “**Candyland.com**” for a site that was **sexually explicit**.
 - **The same result as in Toys “R” US.** **Candyland** was famous. The sexually explicit site was enjoined.

The “Anti - Cybersquatting” laws.

- After the defendants lost the first cases, they would **register** a domain name, **but not use it** and either try to sell it or wait until the corporate owner found out about it.
- **AHA !!** Now there was not jurisdiction over the defendant because there was no “use in commerce.”
- Congress passed **15 U.S.C. § 1125 (d), the Anti-cybersquatting Consumer Protection Act (Section 43(d) of the Lanham Act.)**
- It prevents “**one who with bad faith, registers, uses, or traffics in**” a confusingly similar mark.
- Now, there **is jurisdiction for registering a mark in bad faith.**

“Bad Faith”

- ***Fagnelli Plumbing v. Gillece Plumbing and Heating***, 98 U.S.P.Q.2d 1997 (W.D. Pa. 2011).
- The plaintiff registered the domain name “**fagnelliplumbing.com**” in 2000.
- The defendant, Gillece Plumbing, purchased and registered the domain name “**fagnelli.com**” from the Domain Name Registrar, GoDaddy.
- Defendant purchased and registered the name “**fagnelli.com**” without plaintiff’s knowledge, permission, or consent.
- A customer of Fagnelli’s entered “**fagnelli.com**” in his browser and was directed to the website of ***Gillece Plumbing and Heating***.
- **Gillece** had engaged in **bad faith registration of the domain name**.

“Gripe Sites” – Lucas Nursery

- A “gripe site” is a website is the same as the trademark of the **senior user**, but when one arrives at the site, it is obvious that the person who owns the site **is not happy with the company that he is targeting and is “gripping about it.”**
- ***Lucas Nursery And Landscaping, Inc. v. Grosse***, 359 F.3d 806 (6th Cir. 2004).
- Gross hired Lucas Nursery to correct a dip in the soil of her front yard.
- She claimed that Lucas Nursery did inadequate work.
- She attempted to contact Lucas Nursery to have them rectify the situation and she called the Better Business Bureau.

“Gripe Sites” – Lucas Nursery

- She then registered the domain name, “**lucasnursery.com**,” and posted a webpage for **the sole purpose of relaying her story to the public.**
- When someone went to **lucasnursery.com**, she saw her website that said, “**My Lucas Landscaping Experience.**”
- The website contained numerous complaints about Lucas Nursery, the ineffectiveness of the BBB, and the fact that she had to pay \$4500 to fix the work that Lucas Nursery had done.
- This was a legitimate use, because it was a “**non-commercial**” use on her part.

Lamparello v. Falwell, 420 F.3d 309 (4th Cir. 2005)

- The television evangelist **Rev. Jerry Falwell** had registered and used the website, www.falwell.com.
- Bothered by what he had heard Falwell say about gay people, and about Biblical passages that Falwell had misquoted, **Lamparello** had registered and used the domain name, www.fallwell.com.
- On his website, **Lamparello** had corrected several untruths that **Jerry Falwell** said, and the home page had the following disclaimer: “**This website is NOT affiliated with Jerry Falwell and the ministry.**”
- “If you would like to visit Rev. Falwell’s ministry, you may click ‘HERE,’” and provided a link to Rev. Falwell’s site.

Lamparello v. Falwell, 420 F.3d 309 (4th Cir. 2005)

- Let's look at the websites:
- Rev. Jerry Falwell www.falwell.com
- Mr. Lamparello www.fallwell.com
- The court said that because Lamparello was “**expressing an opinion**” and “not attempting to profit on Rev. Falwell’s name” the use was excused.”
- The Court did not apply “**initial interest confusion.**”
- **There are three types of infringement (two are judicially created):**
- **1) initial interest confusion, 2) point of sale confusion, and 3) post-sale confusion.**

Smith v. Wal-Mart Stores, Inc., 537 F. Supp.2d 1302 (N.D. Ga 2008).

- **Smith** wanted to protest against **Wal-Mart** for various reasons.
- He took out registered and used a website, www.walocaust.com . He had several designs that were related to the Nazis.
- On his site, he said:
- **“THEY HAVE FAMILY VALUES and their ALCOHOL, TOBACCO and FIREARMS are 20% OFF.”**
- **“WAL*OCAUST Come for the LOW prices...stay for the KNIFE fights.”**
- **Smith** also registered and used the domain name, **“walqueda.com,”** and used the slogan to comment on what he thought was Wal-Mart’s terrorist attack on free speech through threats of litigation.

Smith v. Wal-Mart Stores, Inc., 537 F. Supp.2d 1302 (N.D. Ga 2008).

- The court said that **no reasonable person would be confused**, and
- That the use was excused under the **exception to the anti-dilution statute** because it was **non-commercial speech**
- **Smith was not attempting to profit from the website, but he was engaging in expressive behavior by getting his message across.**

People for the Ethical Treatment of Animals v. Doughney, 263 F.3d 359 (4th Cir. 2001).

- **Doughney** had registered 60 different domain names, including www.peta.com.
- When he registered the name, he made **material misrepresentations** to the Internet Registrar.
- He knew that **People for the Ethical Treatment of Animals (“PETA”)** existed and had trademark rights in the name.
- The acronym, in Doughney’s website was “**People Eating Tasty Animals,**” containing links to meat-eating websites and to hunting websites.
- **More importantly, he attempted to sell the name back to PETA.**
- **The court ruled in against Doughney.**
- Compare to *Lamparello*.

Tiffany & Co. v. Ebay, Inc., 600 F.3d 93 (2d Cir. 2010)

- **Tiffany** is a world-famous jewelry manufacturer that now has stores all over the country and the world.
- **eBay** is the world-famous Internet auction site.
- Over time, **Tiffany** found out that about $\frac{3}{4}$ of all listings of **Tiffany** merchandise were **counterfeit**. (73.1% in 2003, and 75.5% in 2004).
- **Tiffany** would alert **eBay** when they found counterfeit listings, and **eBay** would remove them, **but eBay would not search to find the counterfeit listings**.
- **Customers** would also complain to **eBay** that they had purchased **counterfeit merchandise**.
- **Tiffany** sued.

Tiffany & Co. v. Ebay, Inc., 600 F.3d 93 (2d Cir. 2010)

- The **standard for contributory infringement** was:
- **1) Intentionally inducing another to infringe a trademark, and**
- **2) The service provider continues to provide its service to one whom it has reason to know is engaging in trademark infringement.**
- The court said that **eBay** had only a **general knowledge** of infringing articles, not the requisite **specific knowledge** for infringement.
- (But, eBay made \$4.1 million from selling counterfeit Tiffany merchandise).
- And, all of the uses (**keyword advertising, banner ads, pop-up ads, and general listings**) were protected by “**Nominative Fair Use.**”
- **Tiffany** lost the case.

Multi Time Machine, Inc. v. Amazon, 804 F.3d 930 (9th Cir. 2015).

- **Amazon** was sued by **Multi Time Machine (“MTM”)** for trademark infringement.
- When an Amazon user typed **“MTM”** or **“MTM Special Ops”** into the search line, a number of different but **similarly styled watches** were displayed.
- Amazon did not carry **MTM watches**. And it did not say **“We don’t carry MTM watches. Would you like one of these others?”**
- The Court said that **“when a customer is searching for a product using the MTM trademark, the resulting page displays several products, all of which are clearly labeled with the product’s name and manufacturer.”**
- **It is OK for Amazon to do that!**
- **Note that Overstock.com says “We don’t carry MTM watches. Would you like one of these others?”**

Print-on-Demand : *Ohio State University v. Redbubble, Inc.*, 989 F.3d 435(6th Cir. 2021).

- This case came down recently from the Sixth Circuit.
- It reversed and remanded the District Court's holding in favor of Redbubble.
- The case goes against the holdings in *Tiffany (NJ) Inc. v. eBay, Inc.*, 600 F.3d 93 (2d Cir. 2010), and *Multi Time Mach., Inc. v. Amazon.com, Inc.*, 804 F.3d 930, 938–39 (9th Cir. 2015) which held that eBay and Amazon could not be liable for trademark infringement because they did not have “**specific knowledge**” of infringement, just **general knowledge**.

Print-on-Demand : *Ohio State University v. Redbubble, Inc.*, 989 F.3d 435(6th Cir. 2021).

- In the United States trademark infringement cases against eBay and Amazon the online sellers were only an “intermediary” and did not control any of the activity.
- The Courts said that “eBay” (and Amazon) had only a “general knowledge” of infringement and lacked the “specific knowledge” for trademark infringement. (In France, *LVMH v. eBay* and *Hermes v. eBay*, the online marketplace faced liability for selling counterfeits online.)
- **In the United States, the Internet can do no harm...at least up till now.**
- The question in this case was, **“Did Redbubble have enough control and involvement in its site to make it liable for infringement?”**

Print-on-Demand : *Ohio State University v. Redbubble, Inc.*, 989 F.3d 435(6th Cir. 2021).

- **Redbubble** runs a print-on-demand website.
- Users upload images to the website for others to use to make T-shirts, coffee cups, keyrings, etc.
- A customer sees what has been uploaded by other users, and chooses from among the designs that he sees.
- When he sees a design that he likes, he chooses an item on which the design is to be placed.

Print-on-Demand : *Ohio State University v. Redbubble, Inc.*, 989 F.3d 435(6th Cir. 2021).

- **Redbubble takes the designs, places them on the item, ships the item(s) to the customer(s) in Redbubble packaging with Redbubble information inside.**
- **The Sixth Circuit held that unlike eBay or Amazon, Redbubble had enough involvement and control of the entire operation to face liability for trademark infringement.**
- **The case was reversed and remanded to the District Court for additional consideration.**

Copyright “Fair Use” decisions are all over the place !

- Some background on “**fair use**” in the United States.
- For the first years of the new Copyright Act, you could make some generalizations about fair use.
- 1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- The first factor was on a continuum from commercial on one side to educational/non-profit on the other. If it were commercial, an “unfair use” was presumed. It could be rebutted, however.

“Fair Use”

- 2) the nature of the copyrighted work – The nature of the work took into consideration whether the work was informational (which would result in the work having less protection) or whether the work was fictional or creative (which would result in the work having more protection.)
- 3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole. This used to mean the portion used in comparison to the whole copyrighted work. It has changed dramatically in the last few years.
- 4) the effect of the use upon the potential market for or value of the copyrighted work. Courts would look at the actual market **and** the potential market for a work. A copyright holder used to be able to stop another user in an unused and unexploited market.

Fair Use

- ***Campbell v. Acuff-Rose Music***, 510 U.S. 569 (1994) changed everything in “fair use.”
- *Acuff-Rose* was a music parody case. The group 2 Live Crew parodied Roy Orbison’s “Pretty Woman.”
- Some background: In 1990, Judge Pierre Leval wrote an article that appeared in the Harvard Law Review called *Toward a Fair Use Standard*. Judge Leval wrote the article largely to complain about being reversed by the Second Circuit in a number of cases.
- In the article, Judge Leval wrote that **if a new work were transformative** – if it didn’t merely supersede the work but gave it ‘something new’ – **it favored fair use.**

Fair Use

- The choice of the work, “**transformative**,” is unfortunate because the definition of a “**derivative work**” is a work that “**recasts, modifies, or transforms**” a preexisting work. (*See*, “*derivative work*” in 17 U.S.C. § 101.)
- Under § 106(2) of the Copyright Act, to **prepare derivative works** is one of the **exclusive rights of the copyright holder**.
- Buy under Judge Leval’s notion of “fair use” if you “transform” a work, it can be a “fair use?!”
- This is an inconsistency that has bothered judges and professors – especially me -- for years.

Campbell v. Acuff-Rose Music, 510 U.S. 569 (1994)

- Nonetheless, Justice Souter, in *Campbell v. Acuff-Rose* said that “**the more transformative the work, the less the other factors, including commercialism, will matter.**”
- This has become a **mantra for all defendants** in copyright cases.
- He also said that the commercial nature **will not create a presumption against fair use.**

Campbell v. Acuff-Rose Music, 510 U.S. 569 (1994)

- The Supreme Court held that:
 - 1) The Sixth Circuit has committed error by focusing on the commercial nature of the song and holding that it was presumptively unfair.
 - 2) The Sixth Circuit had committed error by not focusing on the fourth factor – the effect on the market
 - 3) The Sixth Circuit had committed error by not considering the market for rap derivatives.
- **The Court remanded the case to the Sixth Circuit; it was remanded back to the District Court...and then settled.**
- **But, the “more transformative the use” language remains !**

Other cases - *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.2d 1257 (11th Cir. 2001)

- Then, “**transformative use**” made it into literature. In *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.2d 1257 (11th Cir. 2001), the Court had to consider whether *The Wind Done Gone* was a parody of *Gone With the Wind* that could be a “fair use.”
- The District Court held that it was not “fair use,” and infringed.
- The Eleventh Circuit reversed from the bench.
- The Eleventh Circuit also held that the **injunction was a prior restraint** (without case law substantiation).
- The 11th Circuit came down with its opinion six months later.

Other cases - *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.2d 1257 (11th Cir. 2001)

- The Eleventh Circuit held that *The Wind Done Gone* had taken the characters, the setting, and to a large extent, elements of the plot from *Gone With the Wind*. (It sounds as though it will not be fair use)
- But...the Eleventh Circuit then said that the viewpoint of the story from the slaves' perspective and the weakness of the white characters in *The Wind Done Gone* was **highly transformative** and was **likely to be “fair use.”**
- The 11th Circuit vacated the injunction and held that Houghton-Mifflin was likely to be successful on the merits.
- The case was remanded to the District Court and then settled.
- This was the first case that involved a **full-length novel as “fair use.”**

Other Cases - *Kelly v. Arriba Soft Corp.*, 336 F.3d 811 (9th Cir. 2003),

- “Fair use” was then applied to “thumbnail photographs” in Internet search results.
- In *Kelly v. Arriba Soft Corp.*, 336 F.3d 811 (9th Cir. 2003), the Ninth Circuit held that “thumbnail” versions of photographs taken from webpages served a **“different purpose” than the original; the “thumbnails” allowed users to find out what pictures were on which websites.**
- The originals were large photographs that were produced for **aesthetic purposes**, and
- They did not compete in the marketplace.
- **Fair Use was found.**

Bill Graham Archives v. Doring Kindersley, Ltd., 448 F.3d 605 (2d Cir. 2006)

- Doring Kindersley (“DK”), a publisher of a coffee-table book about the “Grateful Dead” wanted to include **seven reduced-size images of actual Grateful Dead posters** in the book.
- DK tried to **license the images** from the Bill Graham Archives, who was the copyright holder.
- The BG Archives wanted too much money; so they **published it anyway**.
- The Second Circuit said that the images **served a different function from the originals**.
- The posters in the book **illustrated the timeline of the story**; in the book the illustrations were to **advertise future concerts and for the aesthetic appeal**. **FAIR USE FOUND**.
- **This is a remarkable case, for there is definitely a market for “images in books.” THINK ABOUT ART HISTORY BOOKS !**

Other Cases - *Blanch v. Koons*, 467 F.3d 244 (2d Cir. 2006).

- In *Blanch v. Koons*, 467 F.3d 244 (2d Cir. 2006), the Second Circuit eliminated the satire/parody distinction. If the work was “new” and “transformative” it was “fair use.”
- In that case, artist Jeff Koons took an image from an advertisement, and included a copy of it in a giant mural for the Berlin Guggenheim.



Blanch v. Koons, 467 F.3d 244 (2d Cir. 2006).

- The court said that the new work was “**transformative.**”
- **It had a new and different meaning from the original.**
- This, despite the fact that **Koons** was paid over \$ 2 million dollars to create murals for the Berlin Guggenheim.
- Note: There were **pre-Campbell** fair use cases that **Jeff Koons** lost. I am mentioning pre-Campbell because that is when “**transformative use**” was first used.
- See, *Rogers v. Koons*, 960 F.2d 301 (2d Cir. 1992), and *United Features Syndicate v. Koons*, 817 F. Supp. 370 (S.D.N.Y. 1993).

Other Cases - *Blanch v. Koons*, 467 F.3d 244 (2d Cir. 2006).

- Koons said that he **was commenting on the banality of society.**
- Koons states that he was inspired to create "Niagara" by a billboard he saw in Rome, which depicted several sets of women's lower legs. **By juxtaposing women's legs against a backdrop of food and landscape, he says, he intended to "comment on the ways in which some of our most basic appetites — for food, play, and sex — are mediated by popular images."**
- **"By recontextualizing these fragments as I do, I try to compel the viewer to break out of the conventional way of experiencing a particular appetite as mediated by mass media."**
- **It was found to be "transformative" and a "fair use."**

Other Cases - *Cariou v. Prince*, 714 F.3d 694 (2d Cir. 2013),

- In *Cariou v. Prince*, 714 F.3d 694 (2d Cir. 2013), the district court held that Richard Prince's work infringed Cariou's book of photographs.
- The **Second Circuit reversed in part**. It held as long as the works were "new works" then they could be **fair use**. Twenty-five out of thirty were "transformative" fair uses. The other five were remanded back to the district court.
- **The case eliminated any sense of a parody in the Second Circuit.**
- **When Prince was asked what he was trying to do with the images, he said that he was just trying to make something new.**
- **Then the case settled.**

Other Cases - *Cariou v. Prince*, 714 F.3d 694 (2d Cir. 2013)



Authors Guild v. Google, Inc., 804 F.3d 202 (2d Cir. 2015), cert. denied, ___ U.S. ___, 136 S. Ct. 1658 (2016)

- In *Authors Guild v. Google, Inc.*, 804 F.3d 202 (2d Cir. 2015), cert. denied, ___ U.S. ___, 136 S. Ct. 1658 (2016), Google digitized over 20 million books without authorization from the publishers.
- In fact, the publishers said to Google “Don’t make digital copies.”
- Google said that was insufficient. The publishers had to list each and every book that they did not want digitized.
- The Second Circuit held that “**data searching**” or “**data mining**” was a **completely new use** and held that it was a “**fair use**.”
- Note that in 2011, the Judge in the case (Judge Chin) rejected a proposed settlement because it was “unfair to authors,” and in 2015, Judge Chin held that it was “fair use.”

Cases in Which Fair Use Was Found

- ***Solid Oak Sketches, LLC v. 2K Games, Inc.***, 449 F.Supp.3d 333 (S.D.N.Y. 2020).
- The use of professional basketball players cartoon images with their **tattoos** was a fair use.
- The tattoos as featured in the game did not serve as a substitute for use of the tattoos in any other medium.
- There was also **no evidence** that there was a market for licensing tattoos for use in video games or other media or that such a market is likely to develop.

New Cases - Fair Use Found

- ***Marano v. Metropolitan Museum of Art***, 844 Fed. Appx. 4362021 Copr. L. Dec. ¶ 31,826 (2d Cir. 2021)
- The Met used a photograph of Eddie Van Halen in the catalogue for its exhibit on rock music. Murano was the photographer of Van Halen. The Court said, “..the Met used the Photograph in a **scholarly context** as a historical **artifact to contextualize the ‘Frankenstein’ guitar.**”
- It was put to a **new use.**
- **The Met reduced the Photograph’s size; other surrounding images and text limited its visual impact.**
- The fourth factor, the effect of the use upon the potential market for or value of the work, **avored fair use** because the Met’s use falls into a “transformative market,” not affecting the Photograph’s **original market for photograph collectors of rock and roll legends or of Van Halen.**

Fair Use Found - *Boesen v. United Sports Publs., Ltd.*, 2020 WL 6393010, 2020 Copr.L.Dec. ¶ 31,749 (E.D.N.Y. Nov. 2, 2020), reconsideration denied, 2020 WL 7625222 (E.D.N.Y., Dec. 22, 2020)

- Michael Boesen, a professional photographer, owns the rights in a photograph that he took of professional tennis player, Caroline Wozniacki.
- On December 6, 2019, Wozniacki announced that she would be retiring through an Instagram post using a **smaller and low resolution version of the photograph**.
- The same day, defendant United Sports Publications published an online article about her retirement, and included her Instagram post as an embedded link.
- United Sports did not have a license to use the photograph.

Fair Use Found - *Boesen v. United Sports Publs., Ltd.*, 2020 WL 6393010, 2020 Copr.L.Dec. ¶ 31,749 (E.D.N.Y. Nov. 2, 2020), reconsideration denied, 2020 WL 7625222 (E.D.N.Y., Dec. 22, 2020)

- The court held that the article that United Sports published did not contain a “generic picture” of the tennis player at a young age, **but was a report on the Instagram article, that contained the photograph.**
- The court found that **it was necessary to include the Instagram post to report on the Instagram post !?**
- The photograph did not appear on its own, but appeared **with her avatar, profile name, and additional text making it unlikely that the photograph would compete in the market in the original.**
- Fair use found.

Fair use

- The court is looking for :
 - 1) Whether the second user has merely posted the photograph without anything more, or
 - 2) Whether the user commented on the photograph, or whether the photograph illustrated and contextualized the story.
- Look at the ***Murano v. Metropolitan Museum of Art*** case.
- ***Murano v. Metropolitan Museum of Art*, 844 Fed Appx 436 (2d Cir. 2021)**

Fair Use Not Found – *Dr. Seuss Enterprises v. ComicMix, LLC*, 983 F.3d 443 (9th Cir. 2020).

- Dr. Seuss Enterprises (DSE) publishes children's books that were written by Dr. Seuss.
- Dr. Seuss was a perennially best-selling author with a **well-known distinctive style**.
- ComicMix is a publisher who did its own version of the Dr. Seuss book, called ***Oh, the Places You'll Boldly Go***, which included the Star Trek characters in the plot and used Dr. Seuss's book, ***Oh, the Places You'll Go***, to tell the story.

Fair Use Not Found – *Dr. Seuss Enterprises v. ComicMix, LLC*, 983 F.3d 443 (9th Cir. 2020).

- The Ninth Circuit held that the defendant’s book was not “transformative.”
- It was not a “new message.”
- **It did not comment upon the original book or criticize the original book; it merely used the book as a place in which to have the Star Trek characters.**
- In this way, the Ninth Circuit appears to be holding on to the **parody/satire distinction** and held that it was not a “**fair use**.”
- See, *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997)(using a Dr. Seuss book to tell the story of the OJ Simpson trial -- *The Cat Not in a Hat* – was not a parody, and not “fair use.”)

Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26 (2d Cir. 2021).

- A photographer, shot a photograph of the rock-star (now deceased) named **Prince** for a magazine.
- Unbeknownst to the photographer, the artist **Andy Warhol** (also deceased) made 15 images of the photograph.
- The district court found that they were “**transformative**” and wholly different. The original photograph showed **Prince** as somewhat shy, and the **Warhol photographs** were **distinctly by Warhol**.
- **The Second Circuit reversed.**

Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26 (2d Cir. 2021).

- The Second Circuit reversed.
- They found:
- The print illustrations of the famous musician, based on professional photographer's copyrighted photograph of the musician, **were not transformative**, as would support fair use defense to claim for copyright infringement;
- The artist borrowed significantly from the photograph, both quantitatively and qualitatively;
- The harm to market of original work supported claim for copyright infringement; and
- The resultant screenprint illustrations were substantially similar to photographs.
- **Fair use not found.**

The Georgia State copyright infringement case - *Cambridge University Press v. Becker*

- A case was filed in **2008** by Cambridge University Press, Oxford University Press, and Sage Press against the president of GSU, the head librarian, the provost, etc. (Sovereign Immunity prevents suing the University in name; one can only ask for **prospective injunctive relief against the individuals.**)
- In **2012**, the District Court Judge held that of the 70 or so works in question, many of them did not involve the **real party in interest** so there was no standing, and of the 25 or so works left, **5 of them were not “fair use.”**
- The district court held that:
- 1) all four factors should be afforded **equal weight of 25% each.**

The Georgia State copyright infringement case.

- The Copyright Guidelines for copying were **just guidelines**, and because they were not in the statute, they could be ignored.
- There was a 10% of a book, or one chapter from a journal that was acceptable.
- If there were no **digital licensing program at the publisher** then that was in favor of fair use.
- All of the second factor favored fair use because the works were all college textbooks – they were **informational (Regardless of the title. *The Life of Berlioz* was informational)**.
- Although there were only **five excerpts that were fair use**, GSU was the ***prevailing party***, and was entitled to **attorneys' fees of close to \$3 million**.

The Georgia State copyright infringement case.

- The Eleventh Circuit reversed (for the first time) in **2014**.
- The Eleventh Circuit held that:
 - 1) The Court shouldn't use a mechanical 25%, 25%, 25%, 25% formula for fair use. The factors should be on a case-by-case basis.
 - 2) The Second factor did not always end up to be “informational.”
 - 3) The 10% standard was too rigid. It had to be on a case-by-case basis.
 - 4) The attorneys' fees award was vacated.
- The case was remanded.

The Georgia State copyright infringement case.

- In **2016**, Judge Evans, writing for the District Court again, came out with almost the exact ruling, but by making the four factors a little different in weight. (Her second opinion).
- The rest of the opinion was basically the same.
- In **2018**, the Eleventh Circuit again reversed Judge Evans, and admonished her for not following their instructions (Second reversal.)
- In **2020**, Judge Evans came out with a third opinion, still using flawed methodology, this time finding that seven works were fair use (Her third opinion.)
- The publishers did not file a third appeal in **2020. That is 12 years from the time that the suit was filed.**
- Where is the case now ? Where it was before they started . **Some uses are fair; some uses infringe .**

Copyrightability - *Georgia v. Public.Resource.Org, Inc.*, ____ U.S.____, 140 S.Ct. 1498 (2020)

- The next case, *Georgia v. Public.Resource.Org, Inc.*, ____ U.S.____, 140 S.Ct. 1498 (2020), dealt with whether a State’s **annotated code** – as opposed to its **unannotated code** – was protected by copyright.
- In this case, Public.Resource.org had published the **annotated version of the code** on a freely accessible website.
- The State of Georgia has **one official code**—the Official Code of Georgia Annotated (OCGA). That Code includes the text of every Georgia statute currently in force, as well as a set of non-binding annotations that appear beneath each statutory provision.
- The first page of each volume of the OCGA boasts the State’s official seal and announces to readers that it is “Published Under Authority of the State.”

Copyrightability - Georgia v. Public.Resource.Org, Inc., ____ U.S. ____, 140 S.Ct. 1498 (2020)

- The State of Georgia sued for copyright infringement.
- The District Court had held that the **annotated version** had infringed.
- The Eleventh Circuit **reversed** saying that it had been authored by the legislature under the **government edicts doctrine**, and **there was no copyright available because it was a government work**.
- The Supreme Court granted *certiorari*.

Copyrightability - *Georgia v. Public.Resource.Org, Inc.*, ____ U.S. ____, 140 S.Ct. 1498 (2020)

- The Supreme Court, in another **5-4** decision, held that the **annotated version:**
- 1) was created by Lexis/Nexis under a “work made for hire” agreement with the the Code Revision Commission, a state entity composed mostly of **legislators, funded through legislative branch appropriations, and staffed by the Office of Legislative Counsel.**
- 2) The agreement also states that any **copyright in the OCGA vests in the State of Georgia, acting through the Commission.**

Copyrightability - *Georgia v. Public.Resource.Org, Inc.*, ____ U.S.____, 140 S.Ct. 1498 (2020)

- A careful examination of our government edicts precedents reveals a straightforward rule based on the **identity of the author**. Under the government edicts doctrine, judges—and we now confirm, legislators—may not be considered the “authors” of the works they produce in the course of their official duties as judges and legislators.
- That rule applies regardless of whether a given material carries the force of law. And it applies to the annotations here because they are authored by an arm of the legislature in the course of its official duties.

Copyrightability - *Georgia v. Public.Resource.Org, Inc.*, ____ U.S.____, 140 S.Ct. 1498 (2020)

- **The dissent was in total disagreement.**
- “After straining to conclude that the Georgia Code Revision Commission (Commission) is an arm of the **Georgia Legislature**...the majority concludes that Georgia cannot hold a copyright in the annotations that are included as part of the Official Code of Georgia Annotated (OCGA).”
- “This ruling will likely come as a shock to the 25 other jurisdictions—22 States, 2 Territories, and the District of Columbia—that rely on arrangements similar to Georgia’s to produce annotated codes.”

Copyrightability - *Georgia v. Public.Resource.Org, Inc.*, ____ U.S. ____, 140 S.Ct. 1498 (2020)

- The decision deals with
- 1) **who wrote the annotations ?**
- 2) what was the relationship between the parties ?
- 3) were the “authors” (the State of Georgia under the “work made for hire” doctrine engaged in **legislative activity** to render the works **uncopyrightable ?**
- 4) Why did they State say “Published Under Authority of the State” with Georgia’s Official State Seal ?
- It will send a message to other States to revamp their documents dealing with the **Annotated State Statutes.**

Sovereign Immunity

- **The Eleventh Amendment of the U.S. Constitution provides:**
- **“The Judicial power of the United States shall not be construed to extend to any suit in law or equity, commenced or prosecuted against one of the United States by Citizens of another State, or by Citizens or Subjects of any Foreign State.”**
- It was passed to deal with disputes over **war bonds** in the period after the **Revolutionary War**. (The treasury of any state was more important than any individual speculator.)
- Should it deal with **violations of federal law** ?
- Also note, that by its language, it prohibits citizens of **one state** from suing **another state**. (It was expanded to cover citizens suing their home state by the Courts in *Hans v. Louisiana* (1890).)

Sovereign Immunity

- In 1985, the U.S. Supreme Court, in *Atascadero State Hospital v. Scanlon* dismissed an employment discrimination case because Congress had not provided the requisite “**unequivocal statutory language**” in the Rehabilitation Act of 1973 necessary to abrogate state sovereign immunity.
- Following *Atascadero*, in 1988 and 1990 the Ninth Circuit held that “**anyone**” in Section 504 of the Copyright Act and “**whoever**” in Section 271 of the Patent Act were just “general language” and not “unequivocal statutory language” to properly put States on notice for a lawsuit. (See, *BV Engineering v. University of California*, 858 F.2d 1394 (9th Cir. 1988), *cert. denied*, 489 U.S. 1090 (1989)(copyright case); see also, *Chew v. California*, 893 F.2 331 (9th Cir. 1990), *cert, denied*, 498 U.S. 810 (1990)(patent case)).

Sovereign Immunity

- Congress then amended the Copyright, Patent, and Trademark statutes to say that **“anyone/whoever shall include a State, an employee of a State, anyone acting under color of State law”** in the applicable statute, and added
- **No doctrine of Sovereign Immunity, under the Eleventh Amendment or under any law shall immunize a State from infringement.**
- After all, **Congress had amended the statutes under guidance from the United States Supreme Court.**
- It should have been good.....

Sovereign Immunity

- But...in 1996, in a case dealing with Native American owned gambling casinos, *Seminole Tribe of Fla. v. Florida*, 517 U.S. 44 (1996), the U.S. Supreme Court, by a **5 – 4 split**, held that **Congress lacked authority under the Commerce Clause to abrogate the state's Eleventh Amendment immunity.**
- The Commerce Clause is found at **Article I, clause 8, section 3** of the U.S. Constitution. Congress shall have power "To regulate Commerce with foreign Nations, and among the several States, and with **the Indian Tribes.**"
- The Copyright and Patent Clause is found at **Article I, clause 8, section 8**. "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."

Sovereign Immunity

- The test case for Patent Infringement and for the Lanham Act was brought. (The case was split into two cases)
- In *Florida Prepaid Post-Secondary Education Expense Board v. Florida*, 527 U.S. 627 (1999), a **5-4 Supreme Court** held that Eleventh Amendment Sovereign Immunity **could not be abrogated by Article I legislation. Therefore, the Congress's Patent Legislation to eliminate Sovereign Immunity was unconstitutional.**

Sovereign Immunity

- But..the **Fourteenth Amendment** came after the **Eleventh Amendment**.
- So, **in theory**, an action to prevent a “**taking without due process and just compensation**” could be maintained under the Fourteenth Amendment.
- But, the Supreme Court said that **there had not been a widespread pattern of violations by States** to support a Fourteenth Amendment claim. (There were only 10 cases until 1990)
- **The State won the case.**

Sovereign Immunity

- *College Savings Bank v. Florida Prepaid Post-Secondary Education Expense Board*, 527 U.S. 666 (1999), was the Lanham Act case.
- It was also decided by a **5-4 vote**.
- The Court said that this was a **false advertising case** not a **trademark infringement case**.
- The Court reiterated that Eleventh Amendment sovereign immunity could not be abrogated by Article I legislation.
- On to the 14th Amendment “takings” claim.
- But it held that **if it were a trademark infringement case**, there might have been a **taking**, but there is **no property right involved** to be free from false advertising.
- **The State won again.**

Sovereign Immunity – *Allen v. Cooper*, 140 S. Ct. 994 (2020).

- Notice that a **copyright infringement case** had not been addressed by the Supreme Court.
- Fast forward to *Allen v. Cooper*, ___ U.S. ___, 140 S. Ct. 994 (2020).
- In *Allen v. Cooper*, Blackbeard’s pirate ship, the *Revenge*, which ran aground on a sandbar a mile off Beaufort, North Carolina in 1718, was located in 1996 by a company called “Intersal.”
- Intersal contracted with a videographer named Frederick Allen to document the operation. For over a decade, Allen created videos and photos of divers’ efforts to salvage the *Revenge*’s guns, anchors, and other remains. **He registered copyrights in all those works.**

Sovereign Immunity – *Allen v. Cooper*, 140 S. Ct. 994 (2020).

- The case deals with North Carolina **publishing Allen's photos and videos on the Internet**. They tried to settle, but could not agree.
- Allen brought suit.
- The Court held that the Eleventh Amendment barred the Article I suit (again.)
- But, the court also said that Section 5 of the **Fourteenth Amendment could not apply because "[t]here must be a congruence and proportionality** between the injury to be prevented or remedied and the means adopted to that end."
- **An infringement must be intentional, or at least reckless, to come within the reach of the Due Process Clause.** (But copyright infringement is a *strict liability* offense.)

Sovereign Immunity

- In this case there was **no intentional or reckless behavior** to justify the Fourteenth Amendment claim.
- Also, citing a report from **1988, there was not an ongoing problem with states infringing copyrights**. The State won the case.
- Well, it had been over 20 years since ***Florida Prepaid***.
- In the last 20 years, there had been about 80 cases that had been heard and dismissed under ***Florida Prepaid***.
- **And, the report that the court relied on was from 1988 !!!**
- **Why not look at present conditions** instead of precedent, especially when the **facts of the precedent are outdated?**

Sovereign Immunity - *Jim Olive Photography v. University of Houston System*, 624 S.W.3d 764 (Texas 2021).

- In this case, handed down by the Supreme Court of Texas on June 18, 2021, the plaintiff filed a “Takings” case in the Texas state courts, instead of a Copyright Infringement case federal court.
- As we have seen, the cases under the Patent Remedy Clarification Act and the Copyright Remedy Clarification Act have been foreclosed under *Florida Post Secondary* and *Allen v. Cooper*.
- Although patent and copyright cases have exclusive jurisdiction in federal court, a “Takings” case under the 5th Amendment and the 14th Amendment are not exclusive to federal court.

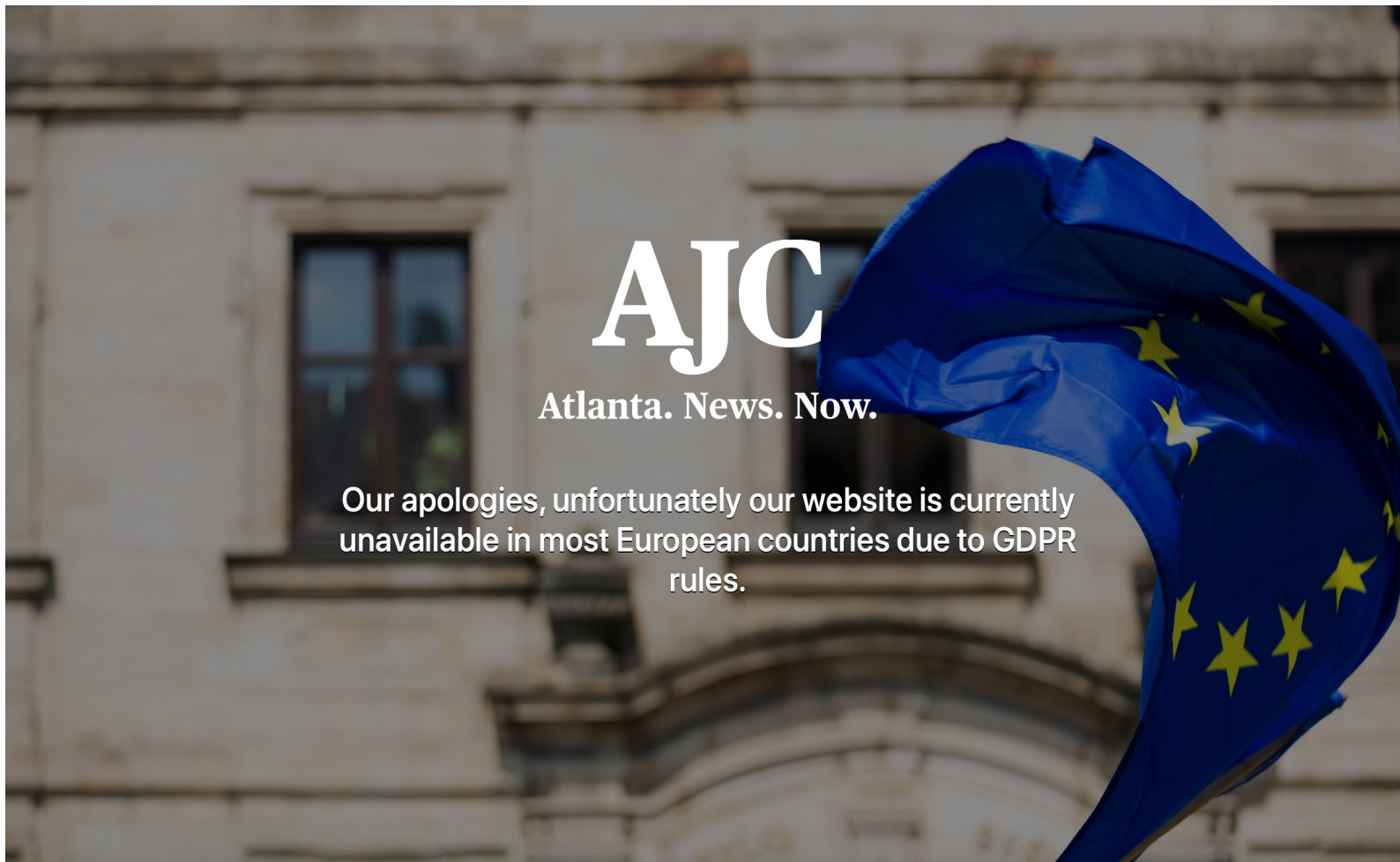
Jim Olive Photography v. University of Houston System, 624 S.W.3d 764 (Texas 2021).

- Background: Jim Olive is a photographer who photographed, among other things, the Houston, Texas, skyline.
- In 2005, he posted images of Houston on his website.
- In 2012, the University of Houston took one of his images from his website and **posted it to the University of Houston website** to promote the Business School at the U of H.
- When Olive found out about it, he contacted the University; the University then took the photo down.
- But the University refused to pay him for the use of the photograph.

Jim Olive Photography v. University of Houston System, 624 S.W.3d 764 (Texas 2021).

- **Olive sued.**
- He brought the case under the “Takings” clause of the 5th Amendment and the Texas constitution.
- The court said that **“Copyright infringement is not a taking because the state didn’t confiscate your property.”**
- **“The state merely used the copyright without paying you”**
- The court distinguished between **tangible physical property** and **intangible intellectual property**.

The Atlanta Journal's home page with a VPN set to the Netherlands.



Additional Readings (if you so desire...excuse the plug!)

- Michael B. Landau, *The Astounding Growth of “Big Tech” and the Lack of Enforcement of the Intellectual Property, Antitrust, and Contract Laws*, 30 ALB. L. J. SCI. & TECH. 1 (2020).
- Michael B. Landau, *Are the Courts Singing a Different Tune When it Comes to Music?: What Ever Happened to Fair Use in Music Sampling Cases?*, 5 IP THEORY 1 (2015).
- Michael B. Landau, *State Sovereign Immunity and Intellectual Property Revisited*, 22 FORDHAM INTELL. PROP., MEDIA & Ent. L.J. 513 (2012).
- Michael Landau, *Fair Use Under U.S. Copyright Law : The Need for Clarity and Consistency*, SE/2006 IPR Info 25 (2006).
- Michael Landau, *Copyright, The First Amendment, and the Right of Publicity: The Expansion of “Transformative Use.”*, 21 COMPUTER AND INTERNET LAWYER 13 (March 2004).
- Michael B. Landau, *Problems Arising Out of the Use www.trademark.com: The Application of Principles of Trademark Law to Internet Domain Name Disputes*, 13 GA. ST. U. L. REV. 456 (1997).